

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

DE RODRIGUEZ et al.

Appln. No. 09/764,783

Filed: 01/17/2001



Examiner: Chakrabarti, Arun k

Art Unit: 1655

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For: METHOD OF PROCESSING BLOOD SAMPLES IN ORDER TO PRODUCE DNA
COMPLEX PATTERNS FOR DIAGNOSTIC APPLICATIONS

* * *

REQUEST FOR RECONSIDERATION

In response to the Official Action dated 1 July 2001 in the above-identified case, reconsideration is requested of the Examiner's decision to make the Official Action final. This request is premised on telephone discussions between applicant's previous attorney and the Examiner in this case. During said discussions, the Examiner and applicant's previous attorney of record had reached agreement as to the scope and content of the claims, and the Examiner had indicated directly to Applicant that he was prepared to allow the claims as amended.¹ Applicant duly made the proposed amendments and submitted a Response, but rather than allowing the claims as had been indicated they were rejected again for exactly the same reasons. Apparently the Examiner's supervisor had a different view and the telephone discussions were for naught. Regardless of the merits of the 112 rejection, the Examiner's about-face has deprived Applicant of the opportunity to amend the claims more fully in order to traverse the original rejection, and applicant is desirous of making the claim changes herein obligatory, and not discretionary as per final rejection. Accordingly, the applicant respectfully requests that the finality of the rejection be withdrawn.

Respectfully submitted,


Royal W. Craig, Attorney for Applicant
Reg. No. 34,145

Law Offices of Royal W. Craig
10 N. Calvert St., Suite 153
Baltimore, Maryland 21202

¹ This was after applicant's attorney had gone to great lengths to reason with the examiner in regard to his rejection of all pending claims (1-20) pursuant to 35 U.S.C. §112, (first paragraph). Just as now, the Examiner had asserted that the patent application's "specification did not reasonably provide enablement regarding methods for identification of any other change in the body of a human being caused by other physiological or pathological condition. Applicant's attorney argued in earnest that the present method is a qualitative one, and that there was specific guidance (albeit qualitative, and not quantitative efficacy studies). At that point the Examiner was in agreement, and had indicated that he was prepared to allow the claims with proposed amendments.